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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 9

Application Number: 10/010,202
Filing Date: December 10, 2001
Appellant(s): SPRINGETT ET AL.

Jerome D. Drabiak
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on 03/27/2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or

have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1, 2, 4-6 and 8-10 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO97/21867	Franke	06/1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 4-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Franke (WO 97/21867) cited in the IDS dated 12/01/01).

With respect to claim 1, Franke discloses a transfer sheet, including: a carrier sheet (element 1 in the only drawing; page 11, lines 31-34), a colored pattern (element 5 of the figure, page 12, lines 2-3) printed on a surface of said carrier sheet using at least one digitally controlled color printer; and a layer of white-pigmented layer (page 12, lines 6-7) printed configuratively by silk screen printing on the pattern.

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

With respect to claim 2, Franke discloses a transfer sheet, including: a carrier sheet (element 1 in the only drawing; page 11, lines 31-34); a colored pattern (element 5 of the figure, page 12, lines 2-3) printed on a surface of said carrier sheet using at least one digitally controlled color printer; and a layer of white-pigmented layer (page 12, lines 6-7) printed configuratively by silk screen printing on the pattern.

further including a layer of glue (page 12, lines 7-9; element 8 of the figure)positioned over at least said layer of white colored material wherein said layer of glue includes a heat activatable thermoplastic polymeric glue; whereas as recited in claim said layer of glue is printed over said layer of white colored material by using the digitally controlled color printer (present claim 8).

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

With respect to claim 4, Franke discloses a transfer sheet, including: a carrier sheet (1); a colored pattern (5) printed on a surface of said carrier sheet using at least one digitally controlled color printer; and a layer of white-pigmented layer (page 12, lines 6-7) printed configuratively by silk screen printing on the pattern;

wherein said colored pattern includes: a first layer of colored material, and a second layer of colored material with said first layer of colored material being of a different color than said second layer of colored material (the multi-colored pattern 5 is printed by means of a color printer; page 12, lines 21-25); wherein said first layer and said second layer are printed on said carrier sheet at least partially in superimposed registration with one another (present claim 5).

With respect to claim 6, Franke teaches the limitation "wherein said layer of white colored material is printed over said first layer and said second layer" (page 12, lines 6-7).

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

With respect to claim 9, Franke discloses a transfer sheet, including: a carrier sheet (1) , a colored pattern (5) printed on a surface of said carrier sheet using at least one digitally controlled color printer; and a layer of white colored material (page 12, lines 6-7) printed configuratively by silk screen printing on the pattern wherein said layer of white colored material includes a toner material (page 13, lines 10-14).

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

With respect to claim 10, Franke discloses a transfer sheet, including: a carrier sheet (1) ; a colored pattern (5) printed on a surface of said carrier sheet using at least one digitally controlled color printer, and a layer of white colored material (page 12, lines 6-7) printed over at least the colored pattern using silk screen printing, further including a transparent layer (element 4 of the figure; page 11, line 35-36) printed on the surface of said carrier sheet (1) with said colored pattern (5) being printed thereover.

It should be noted that it is well settled that "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production." In re Thorpe, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, the processes used to deposit the various layers are not given patentable weight.

(11) Response to Argument

The claims presently before the Board of Patent Appeals and Interference, claims 1, 2, 4-6 and 8-10 are rejected under 35 USC 102(b) over Franke (WO 97/21867) for the reasons set forth at pages 2-3 of Paper Nos. 4 and 6. Essentially the elements of the claimed transfer sheet except the process step used to deposit the various layers of the transfer sheet are met by Franke. The Examiner has taken the position that the process used to deposit the various layers of the transfer sheet are not given patentable

weight pursuant to the guideline set forth in MPEP 2113 with respect to product-by-process claims.

Appellants agree with the principle that "patentability is based on the product itself" but suggest that current case law stands for the proposition that the patentability of a product ***does*** depend on its method of production, citing Lexis headnotes 11-13 and that portion of the opinion associated with Lexis headnotes 11-13 in the case of Atlantic Thermoplastics v. Faytex, 970 F.2d 834; 1992 U.S. App. LEXIS 15888; 23 USPQ2d 1481 (Fed. Cir., 1992). The Examiner respectfully disagrees with this suggestion as the headnotes 11-13 of Atlantic Thermoplastics v. Faytex clearly suggest that the process limits a product-by-process claim ***only in reviewing for infringement***. As a matter of fact, Lexis headnote 10 -and that portion of the opinion associated with it - of the cited case law clearly states: "A patent applicant ***cannot*** obtain exclusive rights to a product in the prior art by adding a process limitation to the product claim. A new process, although eligible for a process patent, cannot capture exclusive rights to a product already in the prior art."

Further argument is made that anticipation under 35 USC 102 requires the presence in a single prior art disclosure of each and every element of a claimed invention, citing Lexis headnote 1 and that portion of the of the opinion associated with Lexis headnote 1 in the case of Lewmar Marine Inc. v. Barient Inc. (CA FC) 3 USPQ2d 1766. It is argued that since product-by-process claims are limited by and defined by the process, it therefore logically follows that Franke may ***not*** properly be cited as a 35 USC 102 reference against Applicant's claims, if the claims presently before the Examiner disclose a process limitation ***not*** disclosed in Franke. The Examiner respectfully disagree with this argument again for the reason that the it is well settled that ***patentability*** of a product does ***not*** depend on its method of

production. See Lexis headnotes 1 and 2 and that portion of the opinion associated with headnotes 1 and 2 in the case of In re Thorpe, et al., 227 USPQ 964 (CA FC 1985) cited in MPEP 2113.

A further argument is made that it is not possible to define the characteristics which make claims 1, 2, 4-6 and 8-10 inventive over the prior art ***except by referring to the process,*** referring to Atlantic Thermoplastics v. Faytex, 970 F.2d 834; 1992 U.S. App. LEXIS 15888; 23 USPQ2d 1481 (Fed. Cir., 1992) where is is stated that: "the rule is well established that where one has produced an article in which invention rests over prior art articles, and where it is not possible to define the characteristics which makes it inventive except by referring to the process by which the article is made, he is permitted to so claim his article, but is limited in his protection to articles produced by his method referred to in the claims." In this regard the Applellant has ***failed*** to present any convincing argument that the process step in the claimed product imparts distinctive structural characteristics to the final product. See MPEP 2113, citing, e.g., In re Garnero, 412 F.2d 276, 279, 162 USPQ 221, 223 (CCPA 1979) (holding "interbonded by interfusion" to limit structure of the claimed composite and noting that terms such as "welded," "intermixed," "ground in place," "press fitted," and "etched" are capable of construction as structural limitations.)

For the reasons given above, it is respectfully submitted that the Examiner's analysis and application of prior art in a ***patentability*** determination should be maintained.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Huan H. Tran
Primary Examiner
Art Unit 2861

hht
September 9, 2004

Conferees
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